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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,114	10/25/2000	Toru Kobayashi	00745/LH	4404

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EXAMINER

HEWITT II, CALVIN L

ART UNIT PAPER NUMBER

3621

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/696,114

Applicant(s)

KOBAYASHI ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10-25-01.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-123 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-123 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Status of Claims

1. Claims 1-123 have been examined.

Claim Objections

2. Examiner requests Applicant to review all claims and correct spelling and/or grammatical errors, for example, "maser" (claim 14) and "chare" (claim 109).

Claim Rejections - 35 USC § 101

3. Claims 74-93 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility.

Claims 74 and 91 recite a charge set by the service system and another charge set by the client system in order to copy content. However, in order to access content supplied by the service system, the client charge has to coincide with the service system charge. Claims 74 and 91 are vague in this regard.

Claims 75-90 and 92-93 are also rejected as they depend from claims 74 and 91 respectively.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 24-26, 29, 58 and 74-93 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 24, recite the limitation " the printer client server" in line 2. Claims 25 and 26 recite the limitation "the job ID information sent from the printer client system" in line 2. Claims 29, recite "the data server" in line 2, and "the obtained data storing location" in lines 2 and 3. Claims 58 recite "the frequency" in line 2. There is insufficient antecedent basis for these limitations in their respective claims.

Claims 74 and 91 recites a charge set by the service system and another charge set by the client system in order to copy content. However, in order to access content supplied by the service system, the client charge has to coincide with the service system charge. Claims 74 and 91 are vague in this regard.

Claims 75-90 and 92-93 are also rejected as they depend from claims 74 and 91 respectively.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-4, 7-10, 13, 15-24, 27, 41, 42, 44, 45, 49-56, 59-93, 95-108, 110-117 and 119-123 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Stefik et al. by U.S. Patent No. 6,233,684.

As per claims 1-4, 7-10, 13, 15-24, 27, 41, 42, 44, 45, 49-56, 59-93, 95-108, 110-117 and 119-123; Stefik et al. teach a print system for use through a network comprising:

- a service system, with a communication section, connected to a network having a storage section in which a plurality of data are stored in a plurality of data storing locations and a calculating section to calculate a payment to be charged in accordance with the printing result (abstract; figures 1, 2 and 5)

- a plurality of printer client systems, each with an information processing apparatus, for accessing the service system through the network, requesting data from a service data storing location, downloading requested data, and selects a printer for printing on the basis of the requested data (figures 3 and 5; column 7, lines 10-20)
- a printer client system with a finishing section, print failure detection section that indicates a success or failure of image formation and transmits an indicator of the result, and charges payment on the basis of successful printing(s) (column 13, lines 10-19)
- a communicating system notifying the service system of the printing result by the client system (column 13, lines 10-19)
- calculating a payment to be charged in accordance with the printing result (column 13, lines 10-19)
- encrypting the requested data by the service system and the printer client system downloading the encrypted request data, decrypting the data and conducting printing on the basis of the decrypted data (figure 5)
- a service system storage section comprising a data server to store a plurality of data at the plurality of data storing locations and a

master server to store data regarding the plurality of data storing locations (figures 1 and 2; column/line 6/28-7/10)

- transmitting stored estimated payment information (e.g. relating to royalties, service charge for providing image data) to the client system, by the service system (e.g. data server, master server) and the client system indicating a payment on the basis of the payment information (e.g. calculating a copy charge) (abstract; figures 6 and 7; column 5, lines 7-10; column 9, lines 14-60; column 13, lines 10-19)
- transmitting order signal from client system to master server and job ID information to the printer client system in response to the order (figures 5-7)
- server specifying data on the basis of job ID information and printer client system (figures 5-7; column 18, lines 20-40)
- transmitting a data storing location to the printer client system (figures 5-7)
- a service system, data server that performs data conversion (figure 8; column 5, lines 1-8 and 35-46)
- a master server acting as a data server (figures 1-3; column/line 6/28-7/9)

- the storing of charge information at the service system and client system, and calculating a copy charge based on the charge information (figures 5-7 and 12)
- rental fees for content and time limits on data access (column 5, lines 46-59)
- calculating of copy charges by client and service system (e.g. after content rendering) (column 5, lines 7-10 and 45-59; column 6, lines 1-10; column 9, lines 20-60; column 13, lines 10-19)
- storing encrypted charge information (column 15, lines 2-5; column 17, lines 14-17; column 21, lines 1-9)
- printer client system selectively sets image forming conditions and charge information is changed in accordance with a selected image forming condition at the time of the image formation based on the image data (column 5, lines 50-59; column 6, lines 1-10; column 19, lines 15-33)
- setting a rental fee for materials by client system (column 5, lines 47-59; column 6, lines 1-10)
- communicating a data request to a server, receiving a data storing location from a server, accessing the data based on the storage location and downloading the data (figures 12-15; column 13, lines 20-67; column/line 14/22-15/24; column 21, lines 1-9).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684 in view of Yoshiura et al., U.S. Patent No. 6,131,162.

As per claims 5 and 6, Stefik et al. teach a system for secured printing using cryptography (abstract; figures 1, 2 and 5). However, Stefik et al. do not explicitly recite the printer client system applying a digital signature to requested data using public key or other cryptographic scheme. Yoshiura et al. teach a system for securing data where a client system digitally signs requested data using public key cryptography (abstract; figures 2 and 5; column 6, lines 25-34; column 12, lines 12-28). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Stefik et al. and Yoshiura et al. in order to identify illegal copies of content ('162, abstract; column 3, lines 14-28; column 11, lines 30-48).

10. Claims 11, 12, 29-35, 37-39, 57, 58, 109 and 118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684 in view of Hatrick et al., U.S. Patent No. 5,532,920.

As per claims 11, 12, 29-35, 37-39, 57, 58, 109 and 118, Stefik et al. teach a system for secured printing that allows users to download digital works and compensates creators for the use of their digital works, uses cryptographic communications to exchange data between server and client, notifies the server system of successful printing and processes based on the print result (abstract; figures 1, 2 and 5-7; column 13, lines 10-19). Stefik et al. also teach billing a user after it is verified that successful printing took place (column 13, lines 10-19). Therefore, to one of ordinary skill it would have been obvious to consider unsuccessful attempts as "trial" printing. However, Stefik et al. do not explicitly recite book printing or page printing. On the other hand, Stefik et al. apply their system to document printing (column 13, lines 43-45). Hence, a user has the ability to print a one page or multi-page document and select the frequency for printing each page (figure 12). Hartick et al. teach a system for compensating content creators for the right to access digital works on a book or chapter basis (abstract; figures 9A-11; column 12, lines 8-20) and a service system that changes a page arrangement order in accordance with a processing capability of the printer client system such as a selected access mode (e.g. chapter or book) (column 12, lines 8-20). In addition, it would have been obvious to one of

ordinary skill to not apply copyright fees if the copyright has terminated.

Therefore, it would have been obvious to one of ordinary skill to combine the systems of Stefik et al. and Hartick et al. in order to provide a user with the ability to access portions of a digital work as opposed to accessing the entire work ('684, abstract; '920, figure 11; column 12, lines 9-18).

11. Claims 14 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684 in view of Servi, U.S. Patent No. 5,278,904.

As per claims 14 and 40, Stefik et al. teach a system for secured printing that allows users to download digital works and compensates creators for the use of their digital works (abstract; figures 1, 2 and 5-7). However, Stefik et al. do not teach logging on to a server. Servi et al. teach a system for verifying a requester comprising a client system logging on to a server and the server certifying the log-on request (figure 1; column 1, lines 12-33; column/line 2/40-3/2). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Stefik et al. and Servi in order to prevent unwanted access to the system.

As per claims 25, 26 the recited limitation of collating job ID information sent from the printer client with job ID information a master server is analogous to the id code and password verification process taught by Servi (figure 1).

Therefore, it would have been obvious to one of ordinary skill to combine the systems of Stefik et al. and Servi in order to protect access to printing resources.

12. Claims 28, are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684 and Servi, U.S. Patent No. 5,278,904, as applied to claim 14 and in further view of Yoshiura et al., U.S. Patent No. 6,131,162.

As per claims 28, Stefik et al. teach a system for secured printing that allows users to download digital works and compensates creators for the use of their digital works (abstract; figures 1, 2 and 5-7). Servi et al. teach a system for verifying a requester comprising a client system logging on to a server and the server certifying the log-on request (figure 1; column 1, lines 12-33; column/line 2/40-3/2). However, neither Stefik et al. nor Servi explicitly recite digital signatures. Yoshiura et al. teach a system for securing data where a client system digitally signs requested data using public key cryptography (abstract; figures 2 and 5; column 6, lines 25-34; column 12, lines 12-28). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Stefik et al., Servi and Yoshiura et al. in order to further secure the system ('904, figure 1) by incorporating the ability to identify illegal copies of content ('162, abstract; column 3, lines 14-28; column 11, lines 30-48).

13. Claims 43, 46-48, 82 and 105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684 in view of Kao et al., U.S. Patent No. 5,901,067.

As per claims 43, 46-48, 82, 94 and 105, Stefik et al. teach a system for secured printing that allows users to download digital works and compensates creators for the use of their digital works (abstract; figures 1, 2 and 5-7). Stefik et al. teach rental fees for materials (column 5, lines 45-60). However, Stefik et al. do not explicitly recite apparatus rental. Kao et al. teach storing data corresponding to a rental fee for an apparatus (abstract; figures 2-6B and 9; column/line 5/63-6/45; column/line 7/45-8/17). Therefore, it would have been obvious to one of ordinary skill to allow users to rent computers and/or computer peripherals in order derive income from users who do not own and/or only desire temporary access to computers and computer peripherals for accessing, rendering and/or printing digital works.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:
- Dreyer et al. teach an electronic printing press that reprints books on demand

- Farros et al. teach a system for creating printing products
- Griencewic teaches electronic books
- Krist et al. teach a method and apparatus for composing print jobs and remote printing
- Mastic teaches a system for creating a document out of a plurality of files and printing the document

15. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

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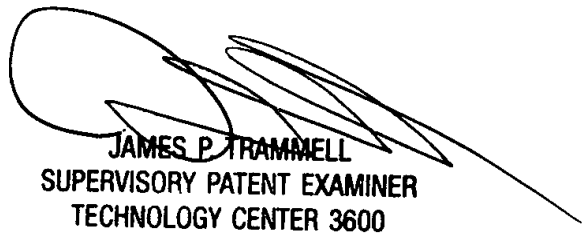
(703) 746-5532 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application
should be directed to the Group receptionist whose telephone number is (703)
308-1113.

Calvin Loyd Hewitt II

May 15, 2003



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
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